



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mike O'Donnell and Andrew Cameron  
Title: AUTOMATED LICENSING AND DELIVERY OF COPIES OF  
WORKS OF AUTHORSHIP, WITH PROOF OF LICENSE  
(twice amended)  
Serial No.: 09/245,798  
Filing Date: February 5, 1999  
Examiner/Unit: Beth Van Doren / 2700  
Attorney Docket No.: 1690-001-01

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited in the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief Patents, Commissioner for Patents, P O Box 1450 Alexandria, VA 22313-1450 on this 14<sup>th</sup> day of July, 2008.

  
Signature

Mail Stop Appeal Brief Patents  
Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

In response to the Examiner's Answer dated May 13, 2008 please enter the following:

Before getting into the particulars of the claims and arguments, it may be helpful to provide an overview of the system taught by the present patent application. The material below consists of illustrative examples. The examples below were copied from a computer display as the system has been implemented. Each of the features discussed below is taught in the original specification.

See below a sample article from a web page of a publication that has implemented the invented system. (The reader is invited to go to [www.ap.org](http://www.ap.org) and select any of the stories under "AP News on Media Sites".)



E-Mail | Print | Save | Post | Get Photos | Get Reprints | Reuse Options

Jul 8, 1:07 AM EDT


### **German Chancellor Angela Merkel upbeat on G-8, but progress on climate change slow**


By TOM RAUM  
Associated Press Writer


TOYAKO, Japan (AP) -- President Bush and German Chancellor Angela Merkel pledged Tuesday to keep working together on common problems, but progress appeared slow on reaching a consensus on climate change as the Group of Eight major economies tackled that and other knotty global



Note that at the top of the page is a toolbar with a series of hotspot links. Click on any of these links and we see that the user is instantly offered a variety of licensing opportunities for that article:

 iCopyright: Associated Press Content Services


Content Services

**Associated Press**


Article: Bush, German leader meet on G-8 challenges  
Copyright: 2008 Associated Press  
Publication: Associated Press


Live Support  
**OFFLINE**

What would you like to do with this article?





**E-mail this Article**  
Send a link or distribute the entire article to others.







**Make Copies or Order Reprints**  
Print them yourself or have them professionally printed with customizations.







**Post on Your Website or Intranet**  
Get an instant hosted web reprint or order a customized PDF.






**Save this Article**  
Save this article to your personal reading room, hosted by iCopyright.





**Purchase the Photos or Graphics**  
Request permission to purchase or license photos or graphics without the article for use in print, on the web, on a DVD, or other media.



Unlike Johnson, to receive the above re-use offers, the user never sought a centralized repository of licensing information. Unlike Johnson, the user didn't need to request a specific publication or article from a database. Instead, the user is offered the licensing opportunities right at the viewed article itself. Unlike Johnson, the user need not navigate through a plethora of licensing opportunities for a plurality of publications, but is presented with licensing opportunities only for the publication he was viewing.

Now, suppose the user accepts one of the re-uses offered to him for that article. Unlike Johnson, the content is automatically delivered to the user. Depending on the type of re-use selected by the customer this could mean overnight delivery of reprints, a formatted electronic version of the article for use on a website with embedded advertising, a formatted electronic version of the article without ads, an e-mailable form of the article, etc. Whatever the type, (1) the execution of the license is accompanied by delivery of the content, and (2) the content that is received will have a proof of license embedded. Neither of these is contemplated by Johnson; each is valuable and non-obvious, and the combination is revolutionary.

The screen shot below shows an example of what the purchaser/licensee sees upon completing a transaction to obtain a license for one particular re-use service (the right to make copies on one's desktop printer). Please note the sentence "This is your confirmation that your photocopy license has been accepted and your photocopy master is ready for printing." That is, the customer is simultaneously receiving a license and a formatted version of the content for his re-use purposes.



Article: Bush, German leader meet on G-8 challenges  
Copyright: 2008 Associated Press  
Publication: Associated Press

Live Support  
**ONLINE**

## Thank you.

This is your confirmation that your photocopy license has been accepted and your photocopy master is ready for printing. Click the **DOWNLOAD** link to download the master. You will also receive a receipt via e-mail. The photocopy master will also be e-mailed to you.

**DOWNLOAD** 

If you need additional assistance, please e-mail [support@icopyright.com](mailto:support@icopyright.com).

Sign Up for Clip&Copy® to be notified of other articles like this one. It's free!

## Public License Details

|                 |                        |
|-----------------|------------------------|
| Name            | Daniel Sauerhaft       |
| License Number  | 3.5721-2495            |
| Type of License | Instant Desktop Copies |
| License State   | Valid                  |
| Quantity        | 15 copies              |

## About Your Payment

Below is a screen print of the masthead and lead-in paragraph from a sample version of the article that is instantly formatted and delivered to the customer upon obtaining a re-use license. Note that it does not look visually identical to the web site above, but rather has been automatically delivered in a format matching the re-use need of the customer within possible format options set up as requested by the publisher.



July 8, 2008

## Bush, German leader meet on G-8 challenges

By TOM RAUM  
Associated Press Writer

President Bush and German Chancellor Angela Merkel pledged Tuesday to keep working together on common problems, but progress appeared slow on reaching a consensus on climate change as the Group of Eight major economies tackled that and other knotty global

[remainder of article omitted]

At the bottom of the article that is instantly delivered to the purchaser/licensee is a proof of license tag. The proof-of-license tag generated by the system and inserted in the delivered content looks as follows:

Reprinted from Associated Press.



© 2008 Associated Press. All rights reserved. Licensed by Daniel Sauerhaft for 15 copies on July 8, 2008. You may forward this article or obtain additional permissions at the following iCopyright license record and renewal locator: <http://license.icopyright.net/3.5721-2495>. Press Association and Associated Press logos are registered trademarks of Press Association. The iCopyright logo is a registered trademark of iCopyright, Inc.

The proof of license tag is automatically shown to everyone who views the content. Not on a selective basis. Not upon request. Automatically, to everyone. If the re-used version of the content is used on the web, anyone viewing the content can click on the license number and be brought to a web page that gives license verification and details. If the content is in hardcopy form, any reader can see the license number, input it into a browser, and instantly see the proof of license. An example of the license verification that the user sees upon clicking the footer or inputting the URL into a browser is shown below:



Article: Bush, German leader meet on G-8 challenges  
Copyright: 2008 Associated Press  
Publication: Associated Press

Live Support  
**ONLINE**

## License Record

As of July 8, 2008, our database contains the following information about that license.

|                 |                        |
|-----------------|------------------------|
| License Number  | 3.5721-2495            |
| License Date    | July 8, 2008           |
| Type of License | Instant Desktop Copies |
| Licensee        | Daniel Sauerhaft       |
| License State   | Valid                  |
| Quantity        | 15 copies              |

You can get a new license on this content at any time.

**CANCEL** 

Please honor copyright! Piracy hurts creators, devalues their works, and puts you and your employer at risk. [Learn more.](#)

Copyright 1998-2008 iCopyright, Inc. All rights reserved, patent-pending.  
[Terms of Use](#) | [Privacy Policy](#) | [My Account](#) | [Clip&Copy®](#)

Since the license can be instantly verified, the mere appearance of this license tag on an article serves as a strong indication of legitimacy. Similarly, and more importantly, once the system is ubiquitous, the absence of such a license tag provides strong indication of non-legitimacy. So the ability of everyone to click on the license tag to instantly see if the re-use is legitimate is very important. But great value is also provided simply by having the license tag there even if no one clicks on it.

To illustrate the importance of this approach, consider an HOV (High Occupancy Vehicle) lane. Why do HOV lanes work so well? The HOV lane is free of charge and uncrowded. Statistically, violators are rarely stopped and caught -- there aren't enough police to catch most violators. So why doesn't everyone violate the law and use it even when there is a single occupant in the car? The answers, of course, are social conscience and the risk that another driver (a "peer" or "competitor") will make a cell phone call to report your violation. Because car windows are transparent, a car with a single passenger traveling in an HOV lane will be immediately visible to all other travelers. He will be the object of scorn, as his behavior is considered unfair to all other travelers on the highway. He might be reported by a peer or competitor. The invented license tag system is based on the same principle. If you don't have a license tag at the bottom of your re-used content, it is a highly public, immediately visible admission of infringement. Like the violator in the HOV lane, the transparency of the system and communal interest in compliance reduces violation to low levels even without (a) a mechanical system to prevent violation or (b) policing, other than by peers, to catch violators.

Note that the system works because of (i) the ease of obtaining the license in the first place so it becomes ubiquitous (not taught by Johnson), (ii) the immediate and automated delivery of the content in an appropriate format with the license tag included (not taught by Johnson), (iii) the ability of any reader to immediately verify the license is legitimate by clicking on it (or, for hard copy, inputting in a browser)(not taught by Johnson), and (iv) the transparency, public shaming, and risk of peer enforcement that violators are subject to by not having a license tag on re-used content (also not taught by Johnson).

Let's return to the innovation of delivering the formatted content simultaneously with issuance of the license. While the automated delivery of the formatted content makes re-use convenient and attractive for the customer, it serves another function -- it ensures that the version the customer re-uses has the license tag at the bottom! Without the automated delivery, the customer would simply "cut and paste" or xerox the licensed content, and the licensed content would appear without the license tag at the bottom. Like an HOV lane where all cars have tinted windows and no license plate, transparency would disappear and the whole system would collapse. There is no



reason a person of skill in the art would think to implement automated delivery if he weren't trying to insert a license verification tag at the bottom. The concept of delivering a license and reformatted content simultaneously arises in large part because of the need to insert a license verification tag at the bottom of the re-used content.

Unlike prior art, this system is not based on centralized offering pages of permissions that a user seeks out in order to request a re-use permission. Rather, the permission is actively offered to the user without being sought, is offered at the point of interaction with the content, and is offered specifically for that piece of content alone. Unlike prior art, this system addresses the problem of copyright infringement without mechanical or digital obstructions to infringement. Unlike prior art, this system delivers the content appropriately formatted with proof of compliance inserted. The license verification tag allows anyone to verify the validity of the license and the absence of the tag indicates a high probability of infringement (and, as the tags become ubiquitous, a certainty of infringement). This system bears little resemblance to any prior art systems and overcomes the failings of all previous systems.

### **Reply to argument on claims 129 and 145**

Like the opening brief, this reply brief focuses first on method claim 129 and corresponding system claim 145, because those are the most important and most revolutionary pending claims. The examiner's argument about these claims is contained in one paragraph in the middle of page 7 of her brief and on pages 20-22.

Claims 129 and 145 concern methods for rights management – reducing unauthorized copying of works of authorship. All of the prior art before the present application focused on technical means to either make it very difficult for unauthorized would be copiers to make copies (copy protection) or make it technically provable if they did so (such as via “watermarks”). No prior inventors in this field approached the problem from an understanding that humans are social animals and that their behavior is affected by social pressure, a basic desire to do the right thing, and the effectiveness of giving peers an enforcement tool but offering no compensation to the enforcers.

The inventor of claims 129 and 145 recognized these aspects of human nature and devised a technical means to take advantage of them to discourage unauthorized copying. He set up a system where it can become the social norm to offer easily verifiable proof of authorization in the form of a web page accessible by anyone from any computer with access to the world wide web so that anyone can easily verify whether authorization was given for any copied work of authorship. This allows peers and competitors – who have an incentive to do so -- to check whether license fees were paid and rat on violators if they were not.

In her paragraph on page 7, the examiner says, in effect, that the Johnson system has all the required hardware and even has all the database fields set up. To convert the system of Johnson to the claimed system, all one must do is write a simple report generator routine that is accessible to anyone on the world wide web. The report generator routine would report out selected information from the database. True enough. But the mere fact that it is easy to create the claimed system does not mean it is obvious to create that system.

All of the prior art systems to discourage unauthorized copying teach nothing like what is claimed. For this reason, the examiner has cited none of them in her rejection. Johnson does not disclose a system or method to discourage unauthorized copying. The system of Johnson is for would-be copiers merely to obtain authorization to copy – it teaches nothing about discouraging unauthorized copying. Johnson teaches that the data in the database fields indicating whether a license for a use has been granted should not be made viewable by the general public but should be made viewable only by administrators. Thus, Johnson teaches away from the claimed invention.

The examiner states that it is well known that any data fields associated with a web site can be given a low security level so that anyone can view them. True. But this is not the claimed invention. The claimed invention is a combination of such a security setting with the other elements of the claim. All prior art systems with the other elements of the claim had high security settings for these data fields to make them viewable only by an inner circle of people, and no prior art developer published the idea there could be any advantage to making those data fields – or lack of such data fields -- viewable by

everyone and this would present an advantage that would outweigh the loss of confidentiality.

One approach to assessing whether an invention is obvious consists of:

- (a) identifying the closest prior art, i.e., the most relevant prior art;
- (b) determining the objective technical problem, i.e., determining, in the view of the closest prior art, the technical problem which the claimed invention addresses and successfully solves; and
- (c) examining whether or not the claimed solution to the objective technical problem is obvious for the skilled person in view of the state of the art in general.

This last step is conducted according to the "could-would approach". Pursuant to this approach, the question to address to assess whether an invention is obvious is the following (climax of the problem-solution approach):

Is there any teaching in the prior art as a whole that would, not simply could, have prompted the skilled person, faced with the objective technical problem formulated when considering the technical features not disclosed by the closest prior art, to modify or adapt said closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves?

If the skilled person would have been prompted to modify the closest prior art in such a way as to arrive at something falling within the terms of the claims, then the invention is obvious.

The point is not whether the skilled person could have arrived at the invention by adapting or modifying some prior art, but whether he would have done so because the prior art incited him to do so in the hope of solving the objective technical problem or in expectation of some improvement or advantage.

As stated above, this approach requires an identification of the problem to be solved and then examination of the prior attempts to solve the problem. As stated in the specification of the patent application, the problem to be solved is how to discourage unauthorized copying. Although there is much prior art addressing this problem, the

examiner did not cite this art because it teaches away from the claimed invention. For this reason, the Applicant maintains that the examiner has not made a prima facie case. Considering the approach to solving this problem taken in the prior art, the applicant's approach is surprising. His approach is to set up no impediments to copying and instead provide a social incentive for the copier to get an authorization because anyone can easily verify via the world wide web whether an authorization was obtained.

Another approach to the issue of obviousness is articulated in Winner Int'l Royalty Corp. v. Wang, 202 F.3d. 1340, 1348 (Fed. Cir., 2000) which states that there must be a suggestion or teaching in the prior art to combine elements shown in the prior art in order to find a claim obvious. Thus, in general, the critical inquiry is whether there is something in the prior art to suggest the desirability, and thus the obvious nature, of the combination of previously known elements. This requirement is generally referred to as the "teaching-suggestion-motivation" (TSM) test and serves to prevent against hindsight bias (*In re Kahn*, Fed. Cir. 2006). As almost all inventions are some combination of known elements, the TSM test requires a patent examiner to show that some suggestion or motivation exists to combine known elements to form a claimed invention.

In this case, the examiner has not cited in the prior art any teaching, suggestion, or motivation for creating a system where any authorization granted to each authorized copier can easily be verified by anyone at any time.

The U.S. Supreme Court addressed the TSM test in KSR v. Teleflex (2006). The decision overturned a decision of the Federal Circuit and held that it "analyzed the issue in a narrow, rigid manner inconsistent with §103 and our precedents," referring to the Federal Circuit's application of the TSM test. The court held that, while the ideas behind the TSM test and the Graham analysis were not necessarily inconsistent, a better test of nonobviousness is the Graham analysis.

The factors a court should consider when determining obviousness were outlined by the Supreme Court in Graham et al. v. John Deere Co. of Kansas City et al., 383 U.S. 1 (1966) and are commonly referred to as the "Graham factors". The court held that obviousness should be determined by looking at

1. the scope and content of the prior art;

2. the level of ordinary skill in the art;
3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

In this case, factor 3 is illuminating. The claimed solution to the problem is entirely different from the prior art solutions to the problem. The prior art solutions don't teach, suggest, or motivate a peer-policing method for license verification. |

On page 21 of her brief, the examiner argues that it would have been obvious to change the security settings on records of licenses granted to licensees so that anyone can view them because this would have led to predictable results. Presumably, the predictable result the examiner has in mind is that anyone could view them, resulting in a loss of confidentiality. But the Johnson inventors didn't want to compromise confidentiality, and the Johnson inventors did not conceive of the surprising result that social considerations would then incent people to comply with copyright prohibitions, outweighing the negative effects of loss of confidentiality.

Claims 129 and 145 are allowable because the difference from the prior art leads to a surprising result of encouraging copyright compliance.

#### **Reply to argument on claims 126 and 138:**

In his opening brief, the Applicant showed that the examiner is repeatedly misreading Johnson. Contrary to the examiner's assertion, Johnson does not teach or suggest that a person could place an order for a "copy" of a work of authorship. The only deliverables for which a person might place an order, as taught by Johnson, are "rights". The "rights" that may be ordered in the system taught by Johnson have no embodiments or "copies".

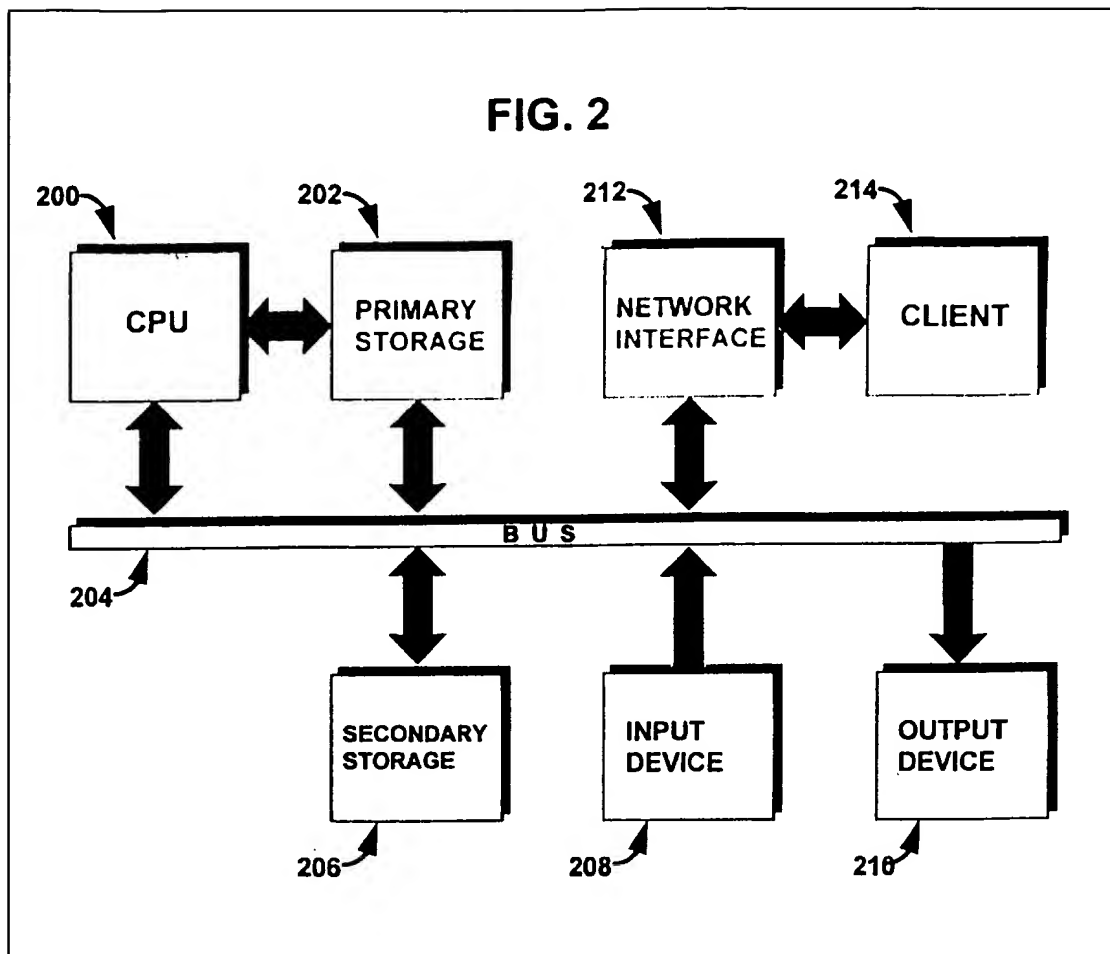
The examiner repeatedly asserts that Johnson discloses "allowing the third computer via the network access to use of an electronic copy of the first work of authorship" (emphasis added). In the middle of page 5 of her brief, using the word "See", the examiner cites six places in Johnson that she asserts support her contention. Then, using the words "See also", the examiner cites again some of the same parts of Johnson

and also adds two more places, for a total of eight places in Johnson that the examiner claims supports her contention.

However, the examiner does not quote any of the words from these parts of Johnson or explain how she concludes that these parts teach “allowing the third computer via the network access to use of an electronic copy of the first work of authorship” (emphasis added).

In his opening brief, the Applicant addressed each of the examiner’s “See also” citations and quoted from each one to show that these passages do not teach that a copy of work of authorship may be sent to the third computer but only that a “right” is granted. The examiner did not respond to these assertions by the Applicant in his opening brief. The examiner offered no quotes from Johnson and no explanation of why she thinks these passages disclose what she says they disclose. With respect to those “See also” citations by the examiner, there is no point repeating what the Applicant has already said or quoted. All that remains is for the Applicant to now show that the parts of Johnson asserted by the examiner for the first time in her responsive brief (the “See” citations) also do not contain the disclosure that she asserts they contain. Each “See” citation is discussed in turn below.

**Figure 2:** Figure 2 teaches nothing relevant. The Johnson specification states: “FIG. 2 shows a block diagram of the components of a computer system to which the present invention applies.” It shows nothing relating to copies of works of authorship or transmission of copies across a network. Here is Figure 2:



**Figure 7:** Figure 7 is discussed on page 17 of Applicant's opening brief.

**Column 3, lines 25-55:** To show that this passage says nothing helpful to the examiner's position, it is quoted below (emphasis added):

Many other enhancements may be added. One such enhancement is the inclusion of a party table to provide detailed data about parties in the system. While parties will generally include all rights holders, parties may include any other individual, group, or organization with a relationship to the rights and authorizations managed by the system. This information may be used for client management, billing and payment, and aggregation functions. A second enhancement is the inclusion of an order table to provide a dynamic log of right authorizations and denials. Those of ordinary skill in the art will conceive of other enhancements to the system herein described.

A rights management and authorization system according to the present invention combines this data structure with one or more software programs or tools for controlling and querying the data structure. Software is provided on the management side for performing work and right maintenance, such as adding, deleting, and editing entries. Software is also provided on the authorization side for querying the database to determine, for example, whether or not to authorize a particular use posed by a potential licensee.

A system according to the present invention may permit rightsholders themselves to add, delete, and edit rights through direct access to the rights management side of the system. A system according to the present invention may additionally or alternatively permit potential licensees to obtain (or be denied) authorizations through direct access to the rights authorization side of the system. Thus, unlike prior art systems, the present invention enables automated rights management and authorization.

**Column 4, lines 55-67:** To show that this passage says nothing helpful to the examiner's position, it is quoted below:

In some computer systems, input device 208 and output device 210 are connected directly to central processing unit 200, rather than through system bus 204.

While the computer system may be limited to the previous elements, the addition of network interface 212 and client 214 adds flexibility to the system and enables operation under the client/server model of computing. Network interface 212 may be a local-area or wide-area network card, a modem, a gateway to the Internet or an Internet service provider, or a similar interface. Client 214 may be a computer system similar to the one used to implement the present invention, or more typically, a low-cost personal computer of the type used in homes or offices.

**Column 9, lines 35-55:** This passage is discussed on page 20 of Applicant's opening brief.

**Column 9, line 55 – column 10 line 15:** To show that this passage says nothing helpful to the examiner's position, it is quoted below (emphasis added):



The data structure from above is combined with one or more software programs or tools for controlling and querying the data structure. Software is provided on the management side for performing work and right maintenance, such as adding, deleting, and editing entries. Software is also provided on the authorization side for querying the database to determine, for example, whether or not to authorize a particular use posed by a potential licensee. The computer software programs for controlling and querying the data structure may or may not be on the same physical data storage space as the data structure, and often will not be.

On the server side of the system for rights management, favorable results have been achieved with a prototype system based on Oracle Version 7.1.3 database software running under Open VMS on a DEC Alpha 2100. An initial commercial system is contemplated in which Oracle 7.2 is used on a DEC Alpha 8200. On the client side of the system for rights authorization, favorable results have been achieved using personal computers with Intel microprocessors and Microsoft operating systems running object-oriented applications built under PowerBuilder Version 4.0. Those of ordinary skill in the art may select and implement the present invention on other computer systems, and could quickly and easily construct a single-user model from a database system such as Access, dBase, FoxPro, or Quattro. It is contemplated that clients may connect to the server side of the system through Internet connections or some other type of on-line link, and communicate with the system through, for example, TCP/IP and/or DCE protocols, or their equivalent.

**Column 10, lines 41-60:** This passage is discussed on page 20 of Applicant's opening brief.

In the discussion above and in his opening brief, Applicant has shown that one of the elements of claims 126 and 138 that the examiner asserts is disclosed by Johnson in fact is not disclosed by Johnson.

The examiner concedes, on page 5 of her brief, that Johnson does not disclose "receiving a request for an electronic copy and that the third computer [is] sent, via the network, an electronic copy of the first work of authorship as a consequence of having

received the message.” But then the examiner follows with another wrong assertion of what is disclosed by Johnson when she says at the bottom of page 5: “the third computer/client is allowed to access and use an electronic copy of the work via the network.” The examiner gives no citation for this assertion. As discussed extensively in the opening brief and above, Johnson does not disclose anything about providing copies of works of authorship over a network.

Claims 126 and 138 focus on “A clearinghouse server system / method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work”. It is a clearinghouse method/system. It is “usable by a plurality of publishers” for “a plurality of works of authorship”. The system offers value to both publishers and consumers because it establishes a single clearinghouse where licensing of works of authorship can be transacted. These parts of the claimed invention are not new. They are disclosed by Johnson. What is new is the idea that the clearinghouse system might be improved so that, once a license is obtained, the customer can request, in the same transaction with the clearinghouse, that an electronic copy of the licensed work be sent to the customer so that the customer does not need to go to the publisher to get any needed copy. The applicant’s invention provides instant delivery of a copy of the work being licensed. Johnson does not contemplate delivery of any part of the work, but only the granting of rights to make a copy, or otherwise make use of the work.

The claimed method has important advantages to both the publisher and user above the mere delivery of rights to make a copy. Delivering the copy itself ensures that the owner’s brand, copyright notice, style sheet, i.e., masthead, font, layout, and links are all included with the copy. In prior art systems like Johnson, limited to only granting rights, the licensee is left to make the copies and thus might exclude the important elements delivered by applicant’s invention. Granting rights is one thing. Granting rights plus the copies themselves ensures that the work will be presented optimally, as desired by the publisher. Thus, the publisher may ensure that the terms of the license with respect to appearance (format) of the copy are adhered to exactly, and not left to the licensee to make the copy in a manner that complies with the publisher’s terms. This is not taught, suggested, or motivated by Johnson. Johnson does not address at all the

question of whether or how the customer might get any needed copy, or whether the copy would comply with the publisher's terms for what elements must accompany the copy. The benefit to the publisher of being able to maintain control over optimal format of each re-use of a work of authorship is a surprising result that would not occur to a person of skill in the art when they think about whether it might be a good idea to deliver an electronic copy of the work when a license is obtained for a re-use.

Without rationale, the examiner baldly asserts that it would be obvious to change the Johnson system to store copies of all the publishers' works of authorship and then send copies of them to licensees upon request. But the examiner cites no prior art that talks about assembling onto one or more servers copies of a plurality of works of authorship from a plurality of publishers. Johnson does not suggest that such a library might be assembled, or that the copies can be automatically delivered from any server. There is no prior art cited by the examiner that suggests the assembling of such a library.

Claims 126 and 138 are allowable because the benefit to publishers of having control over the format of each re-used copy that results from delivering a fresh copy when a re-use license is granted is a surprising result. Also, the examiner has not made a prima facie case because she has not cited any prior art teaching the assemblage of a set of a plurality of works of authorship from each of a plurality of publishers.

**Dependent claims 133, 134, 135, 139, 140, and 141:**

Claim 126 does not specify anything about content of the copy that is transmitted after a license is obtained, as the publisher is free to adjust this content as it wishes. In addition to inventing the method whereby such a copy is transmitted, the Applicant also invented a method of making it easy for readers of the document to read an assertion that a license was obtained and access the license verification pages. That method is to put a hot spot in the published licensed copy which, if clicked on, takes a viewer to the license verification web page. These additional features are specified in claims 133, 134, and 135:

133 The method of claim 126 wherein the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

134. The method of claim 126 wherein the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

135. The method of claim 134 wherein the electronic copy includes a hotspot that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser program to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

Claims 139, 140, and 141 are equivalent to these but in system form.

Claims 133 and 139 stand rejected on a combination of Johnson and Holmes (US patent #6,119,108). Neither Johnson nor Holmes teaches that an electronic copy of a licensed work might be sent to the licensee when the licensee obtains a license. As discussed above, this combination provides a synergy of considerable benefit to the publisher/licensor of ensuring that the copy has a desired format and includes a badge of approval as specified in these claims. When these badges of approval become ubiquitous, they will encourage copyright compliance.

Claims 134, 135, 140 and 141 stand rejected on a combination of Johnson and publications about a system called "Digital Object Identifier" ("DOI").

As pointed out by the examiner, DOI teaches that directing a browser to a URL stated on a document might take a viewer to a web page where a license can be obtained. However, neither Johnson nor the DOI references teach that clicking on a hot spot can take the viewer of a licensed work to a page that verifies the license and neither teaches that a copy with such a hotspot might be delivered when the license is obtained.

As specified in claims 135 and 141, the "lookup" is initiated from the licensed copy itself. Neither Johnson nor DOI anticipates placing a licensing verification link ID on the

copy itself. In Johnson, not only is the owner the only one with access to the database, but if Johnson did write a report to allow anyone to access that database, how would a user do that? The user would not be able to do it from the work itself as with the applicant's claims 135 and 141. They would have to navigate to a website hosted by Johnson, then do a search using the name of the person who has the copy, the name of the publisher, and an identifier of the article to see if that copy was authorized. That is a HUGE advantage of the applicant's invention over the prior art. No such search is needed with applicant's invention as specified in claims 135 and 141. One does not even need to know the copier's name. One just needs to click on a hot spot or enter the ID (which is a URL) into a browser to see if the license is valid. This ease of checking on validity of a license produces the surprising result of encouraging copyright compliance.

**Reply to argument on claims 128 and 142:**

The essential question is whether it was obvious to modify the Elsevier service to be performed automatically, without human intermediation, and combine it with a server for granting reprint licenses on a plurality of works of authorship assembled from each of a plurality of publishers (a clearinghouse) such that the request for a license and the request for a paper copy could be submitted in a single session on the server and, as a consequence, an electronic copy of the work would then automatically be sent by the server system to a printer for printing on paper and delivery. The examiner cites no prior art about assembling a plurality of copies of works of authorship from each of a plurality of publishers. These elements by themselves are novel (although the examiner thinks they are taught by Johnson). The claim goes further and specifies establishing a system for automatic delivery of copies of the works from the assemblage to a printer for printing and delivery as part of a transaction to obtain a license.

A combination of Johnson with the Elsevier service, or any similar service, would not produce the claimed invention because neither reference teaches that an electronic copy might automatically be sent to a printer without a link of human assistance and neither reference teaches assembling the set of many works from many publishers from which the copies might be sent. |

On page 9 of her brief the examiner makes an incorrect assertion about the disclosure of Johnson. She says, at paragraph (f), that the server system of Johnson “allows copying of the work of authorship for printing on paper”. Assuming the word “allows” as used by the examiner (its not in the claim) has meaning in the physical world and means something like “enables to happen”, there is no such disclosure in Johnson. Each of the parts of Johnson cited by the examiner have been discussed above. They teach that a right to make a copy is granted and not that a copy is sent and not even that the system has access to a copy so that it could allow access to a copy if it were programmed to do so.

Claims 128 and 142 are therefore allowable.

**Dependent claims 136 137, 143, and 144:**

Claim 128 does not specify anything about content of the copy that is transmitted after a license is obtained. In addition to inventing the method whereby such a copy is transmitted automatically without need for human mediation, the Applicant also invented a method of making it easy for readers of the printed document to learn that a license was obtained and to access a license verification web page. That method is to print a URL in the printed licensed copy which, if entered in a browser, takes a viewer to the license verification web page. These additional features are specified in claims 136 and 137:

136. The method of claim 128 wherein the copy sent to a printer includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

137. The method of claim 136 wherein the message includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

Claims 143 and 144 are the same but in system form.

The arguments above about claims 133, 134, and 135 also apply here. Neither Johnson nor DOI discloses anything about license verification web pages or the assemblage of a set of a plurality of works of authorship from a plurality of publishers.

Respectfully submitted,  
GRAYBEAL JACKSON HALEY LLP

A handwritten signature in black ink, appearing to read "Jeffrey T. Haley", is positioned above the printed name.

Jeffrey T. Haley  
Patent Agent  
Registration No. 34,834  
155 108th Avenue NE, Suite 350  
Bellevue, Washington 98004-5901  
Telephone: (425) 455-5575  
Telephone: (425) 451-9876 x11  
Fax: (425) 455-1046